

MAR 28 2006

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Firm: USPTO (Group Art Unit 2215)
Fax No.: 571-273-8300 Phone No.: 571-272-4006
Application No. 09/809,581
Subject: Atty. Doc. 08049.0005-00000 Date: March 28, 2006

From: Steven R. Olsen Phone No.: 571-203-2759
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MAR 28 2006

PATENT
Customer No. 22,852
Attorney Docket No. 08049.0005-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Leo J. CAMPBELL et al.)	Group Art Unit: 2155
)	
Application No.: 09/809,581)	Examiner: Benjamin R. Bruckart
)	
Filed: March 16, 2001)	
)	
For: METHODS AND SYSTEMS FOR)	Confirmation No.: 5903
PROVIDING AN ELECTRONIC)	
ACCOUNT TO A CUSTOMER)	

Via Fax to Primary Examiner Saleh Najjar

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

REQUEST FOR WITHDRAWAL OF FINALITY OF PENDING OFFICE ACTION

A final Office Action is pending in the subject application. For reasons stated herein, Applicants respectfully submit that the finality of such action is premature.

The Office issued a first Office Action in the subject application on July 9, 2004. Applicants responded on August 18, 2005, and the Office issued a second and final Office Action on September 29, 2005.

The goal of a final Office Action is to reach clearly defined issues for early termination of prosecution. MPEP 706.07. In particular, a final rejection on second action is not proper "where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims, nor based on information submitted in an Information Disclosure Statement." MPEP 706.07(a).

In the September 29, 2005 Office Action, the Patent Office introduces new grounds for rejection under 35 U.S.C. §§ 102 and 103, citing the Kanevsky reference for the first time. Applicants concede that the Examiner is free to apply new references in a second Office Action. But Applicants' August 18, 2005 Response did not necessitate a new search. Applicants neither added nor deleted any claims. Instead, Applicants made very minor amendments in an effort to clarify the claimed subject matter. For instance, Applicants clarified that an electronic address in a message directed to a user is "associated with the user's electronic account." Likewise, Applicants rephrased "an incomplete physical address" as "a partial physical address." Such changes cannot fairly be characterized as representing a shift in Applicants' claimed subject matter.

In addition, the Examiner raises 35 U.S.C. § 112 issues regarding "a complete physical address" for the first time in the second Office Action. Applicants did not amend this feature in its August 18, 2005 Response. In making the September 29, 2005 Action final, the Examiner has limited Applicants' opportunity to clarify this feature.

In sum, the Patent Office has prematurely cut off prosecution by introducing new grounds for rejection under 35 U.S.C. §§ 102, 103, and 112 that were not necessitated by Applicants' Amendment. Accordingly, Applicants hereby request that the finality of the pending Action be withdrawn.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 28, 2006

By: 

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